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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/422,208 10/19/99 COFFIN

J MASIMO.186A

EXAMINER

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ART UNIT

PAPER NUMBER

2878
DATE MAILED:

05/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/422,208

Applicant(s)

COFFIN, JAMES PRICE

Examiner

Shun Lee

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, an ultraviolet light as recited in claim 7 must be shown in Fig. 3 or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Objections

2. Claims 3-7 are objected to because of the following informalities:
- (a) in claim 3, line 9 on pg. 6, there should be period after "light"; and
 - (b) in claim 7, line 21 on pg. 6, "and" should probably be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Ebnesajjad *et al.* (US 5,888,424).

In regard to claim 1, Ebnesajjad *et al.* disclose a method of detecting an injection molding material, comprising:

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(a) incorporating a fluorescent colorant into the injection molding material (column 1, line 56 to column 2, line 6); and

(b) exposing the injection molding material to ultraviolet light (column 3, lines 28-36).

In regard to claim 2 which is dependent on claim 1, Ebnesajjad *et al.* disclose fabrication by injection molding (column 2, lines 54-59). Fabrication by injection molding is well known in the art. Inherent in the method of Ebnesajjad *et al.* is a step of removing the injection molding material from a piece of an injection mold.

In regard to claim 3, Ebnesajjad *et al.* disclose a method of detecting an injection molding material containing a fluorescent colorant, the method comprising exposing the injection molding material to ultraviolet light and examining the molding material while exposed to the ultraviolet light (column 1, line 56 to column 2, line 6; column 3, lines 28-36).

In regard to claim 4 which is dependent on claim 3, Ebnesajjad *et al.* also disclose that the fluorescent colorant does not change the color of the injection molding material (*i.e.*, is substantially transparent) when not exposed to ultraviolet light (column 1, line 56 to column 2, line 6).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebnesajjad *et al.* (US 5,888,424) in view of Shibata *et al.* (US 4,236,181).

In regard to claim 5 which is dependent on claim 3, the method of Ebnesajjad *et al.* lacks a step of removing injection molding material from an injection mold based upon the detection and the examination while exposed to ultraviolet light. Shibata *et al.* teach (column 1, lines 15-18) removing injection molding material from an injection mold based while detecting luminescence (column 7, lines 3-8) from an examination of the injection molding material while exposed to ambient light (comprising of e.g., ultraviolet light; column 18-28) in order to determine if there is incomplete separation of the molded article from the injection mold. Therefore it would have been obvious to one having ordinary skill in the art to provide a step of removing injection molding material from an injection mold based upon the detection and the examination while exposed to ultraviolet light. in the method of Ebnesajjad *et al.*, in order to ensure complete separation of the molded article from the injection mold as taught by Shibata *et al.*

In regard to claim 6 which is dependent on claim 5, Ebnesajjad *et al.* also disclose that the fluorescent colorant does not change the color of the injection molding material (*i.e.*, is substantially transparent) when not exposed to ultraviolet light (column 1, line 56 to column 2, line 6).

In regard to claim 7, Ebnesajjad *et al.* disclose a method comprising:
(a) incorporating fluorescent colorant with a product; and (column 1, line 56 to column 2, line 6); and

(b) exposing the product to ultraviolet light (column 3, lines 28-36).

The method of Ebnesajjad *et al.* lacks a step of examining the product with an optical testing device which is responsive to the fluorescent colorant when exposed to ultraviolet light. Shibata *et al.* teach examining a product with an optical testing device (see Fig. 1; column 1, lines 15-18) which is responsive to the product (*i.e.*, emitting luminescence; column 7, lines 3-8) when exposed to ambient light (comprising of *e.g.*, ultraviolet light; column 18-28) in order to determine if there is incomplete separation of the molded article from the injection mold. Therefore it would have been obvious to one having ordinary skill in the art to provide a step of examining the product with an optical testing device which is responsive to the fluorescent colorant when exposed to ultraviolet light in the method of Ebnesajjad *et al.*, in order to determine if there is incomplete separation of the molded article from the injection mold as taught by Shibata *et al.*

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US patent 6,207,077 (Burnell-Jones) provides background information as to luminescence from molded articles.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shun Lee whose telephone number is (703) 308-4860. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seungsook Ham can be reached on (703) 308-4090. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

SL
April 26, 2001


SEUNGSOOK HAM
SUPERVISORY PATENT EXAMINER
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